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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,948	11/18/2003	Kimihiro Yoshimura	03500.017715.	3727
5514	7590	11/03/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 11/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,948

Applicant(s)

YOSHIMURA ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/22/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The examiner has considered the copending US application 10/616,944, which is US Published Patent Application 2004/0023139, listed in the Information Disclosure Statement, filed on Jun. 22, 2004.

2. The abstract of the disclosure is objected to because it is not limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

In Fig. 2, the reference characters 2 and 8. See pages 48-50, of the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

In claim 2, the recitation "epoxy modified resol type phenolic resin is obtained by adding a compound having at least

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two epoxy groups in a molecule to the phenolic hydroxy group" lacks antecedent basis in the specification.

5. The term "resol type phenolic resin" recited in the instant claims is defined in the specification as referring to "a compound obtained by the addition and condensation reaction between a compound having phenolic hydroxy groups and aldehydes in the presence of an alkaline catalyst." See page 10, line 26, to page 11, line 3.

6. Claims 1-7 are objected to because of the following informalities:

In claim 1, the article-noun numbers mismatch in the phrase "a phenolic hydroxy groups" (emphasis added).

Appropriate correction is required.

7. Claims 1-7 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

The prior art of record does not teach or suggest an electrophotographic member comprising a surface layer as recited in the instant claims.

Japanese Patent 61-041152 (JP'152) teaches an electrophotographic photosensitive member comprising a

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conductive support having thereon a charge generation layer and a charge transport layer. The charge transport layer comprises a binder resin, a charge transport material, and an epoxy resin for enhancing the adhesion of the charge transport layer. The charge transport layer further comprises a hardener for enhancing the adhesion of the epoxy resin. See the Japanese Patent Office English-language abstract describing JP'152, and the STN CAPLUS abstract An 1986: 505756, entered in STN on Sep. 19, 1986, describing JP'152. JP'152 teaches that the epoxy resin can be an epoxy-modified resol phenolic resin. See JP'152, page 319, col. 2, lines 23. The charge transport layer disclosed by JP'152 appears to meet the compositional limitations recited in the instant claims, but for the presence of the conductive fine particles. On the present record, there is no evidence that JP'152 teaches or suggests that its charge transport layer comprises fine conductive particles as recited in the instant claims.

US 5,693,443 (Nakamura) teaches an electrophotographic photosensitive member comprising a conductive support having thereon a charge generation layer, a charge transport layer, and a surface layer. The surface layer comprises conductive tantalum-doped tin oxide particles dispersed in a curable resin, which can include an epoxy or a resol-type phenol resin.

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Col. 3, lines 19-20; and example 2 at cols. 9-10. However, Nakamura does not teach or suggest that the tantalum-doped tin oxide particles can be used in a charge transport layer or in a surface layer comprising a charge transport material as required in the instant claims.

US 2002/0119382 A1 (Nakata) teaches an electrophotographic photosensitive member comprising a conductive support having thereon a charge generation layer, a charge transport layer, and a surface layer. The surface layer comprises the charge transport compound 1-23 comprising hydroxyl groups, which meets the charge transport material compositional limitation recited in instant claim 5, "conductive fine particles," and a cured "resol type phenolic resin." See paragraph 0035-0037; compound 1-23 at page 7; and example 1 at paragraphs 153-0160. However, Nakata does not teach or suggest that the cured "resol type phenolic resin" is a cross-linked epoxy-modified resol type phenolic resin as recited in the instant claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

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Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Oct. 31, 2004

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700